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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/554,393

10/24/2005

Anders Eckerbom

1515-1039

2779

466 7590 12/23/2008

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EXAMINER

SIMONE, CATHERINE A

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

12/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/554,393	<b>Applicant(s)</b> ECKERBOM ET AL.	
	<b>Examiner</b> Catherine Simone	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/24/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 8-10 and 12 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 9/18/2008.

Applicant's election with traverse of Group I, claims 1-7 and 11, in the reply filed on 9/18/2008 is acknowledged. The traversal is on the grounds that "a finding of allowability of claim 1 of Group I over the art would render the claims of Group II instantly allowable. There is thus no burden placed upon the examiner to rejoin and examine all the claims of the present invention" and "the Office has already performed consideration and search has already been performed and there is thus no additional burden to continue the prosecution of all the claims of the present invention". This is not found persuasive because evidence of lack of unity between the two groups is found in both US 6,806,100 and US 5,067,492 (see rejections below) wherein in each it is found to disclose the features of instant claim 1 and therefore the special technical features of the claimed invention are not found to define a contribution over the prior art. Accordingly, restriction is appropriate. Furthermore, the search required for each Group of claims requires a different field of search, therefore causing a serious burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation "the plastic material is a polyolefin", and the claim also recites "preferably an HD polyethylene" which is the narrower statement of the range/limitation. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

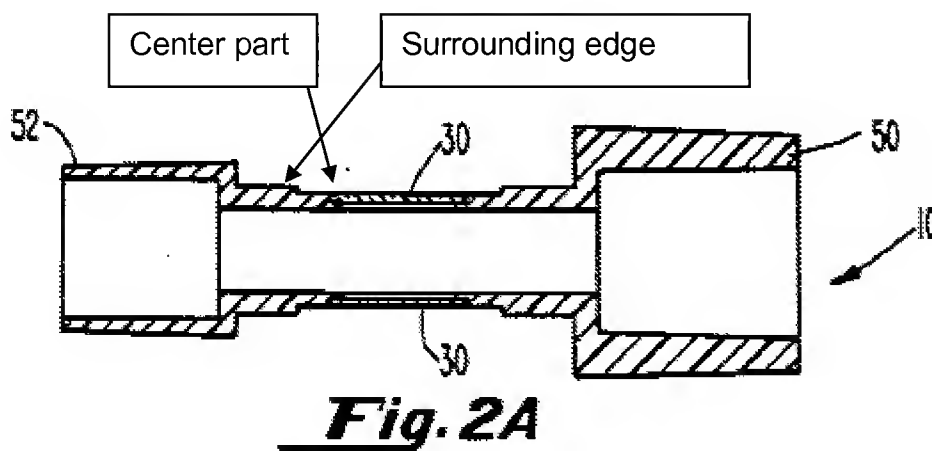
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Yelderman et al. (US 5,067,492).

7. Yelderman et al. teach a window for use in an adapter for an IR gas analyzer for the analysis of respiratory gases, where the gases flow through a through-penetrating passageway in the adaptor with a window disposed on mutually opposite sides of the passageway so that an IR beam can be sent through the windows and the passageway containing the breathing gases, wherein the window is a one-piece structure made of plastic material (Figs. 1A, 1B and 2A, #30; and col. 6, lines 52-55) and having a round basic shape that includes a surrounding edge and a central part which is sunken in relation to the edge and which constitutes the window through which the IR rays shall be able to pass (see Fig. 2A shown below).



***Fig. 2A***

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Regarding claim 2, the plastic material is polyethylene (col. 6, lines 25-26).

Regarding claims 3 and 11, the plastic material includes a surface tension modifying substance (col. 6, lines 24-33 and col. 7, lines 19-26).

Regarding claim 4, note the window is formed by an injection molding process (col. 7, lines 66-68).

Regarding claim 5, note the central part of the window is arched in a direction away from the surrounding edge (see Fig. 2A above).

Regarding claims 6 and 7, the window is glued or fastened by ultrasound-welding or heat welding in a recess in a wall surrounding the through-penetrating passageway in the adaptor (col. 7, line 60 to col. 8, line 2).

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1 and 4-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Xu et al. (US 6,806,100 B1).

10. Regarding claim 1, Xu et al. teach a window having a one-piece structure made of plastic material and having a round basic shape that includes a surrounding edge and a central part which is sunken in relation to the edge and which constitutes the window (Figs. 3, 4 and 9D, #208; and col. 13, lines 15-23 and 32-37). The limitation “for use in an adapter for an IR gas

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analyzer for the analysis of respiratory gases, where the gases flow through a through-penetrating passageway in the adaptor with a window disposed on mutually opposite sides of the passageway so that an IR beam can be sent through the windows and the passageway containing the breathing gases” has been considered, but fails to provide a patentable distinction over the prior art, since the limitation is a recitation of the intended use of the claimed invention and a recitation of the intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As shown above, Xu et al. clearly teaches the structure of the claimed window and therefore is capable of performing the intended use as recited in claim 1.

Regarding claim 4, the limitation “is formed by an injection molding process” has been considered, but fails to provide a patentable distinction over the prior art, since the limitation is a method of production and therefore does not determine the patentability of the product itself. The method of forming the product is not germane to the issue of patentability of the product itself. MPEP 2113.

Regarding claim 5, the central part of the window is arched in a direction away from the surrounding edge (Fig. 4, #208).

Regarding claims 6 and 7, the limitations “has been glued” and “fastened by ultrasound welding or heat welding” have been considered, but fail to provide a patentable distinction over the prior art, since the limitations are methods of production and therefore do not determine the patentability of the product itself. The method of forming the product is not germane to the issue of patentability of the product itself. MPEP 2113.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xu et al. (US 6,806,100 B1).

Xu et al. teach the presently claimed window as shown above except for the plastic material of the window being specifically HD polyethylene and including a surface tension modifying substance. Xu et al. suggest that the plastic material of the window may be any suitable type of material (col. 13, lines 15-17). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the plastic material of the window in Xu et al. to be made from a HD polyethylene including a surface tension modifying substance, since it has been held that a change in the material would be an unpatentable modification in absence of showing unexpected results and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.



*Conclusion*

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571) 272-1501. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Catherine Simone/  
Examiner, Art Unit 1794

/Jennifer McNeil/

Supervisory Patent Examiner, Art Unit 1794